

Application No. 10/589,458
AMENDMENT dated September 28, 2010
Reply to Office Action of June 28, 2010

Remarks

Claims 1-40 are pending. Claims 41-56 are withdrawn. Therefore, claims 1-40 are presently under examination.

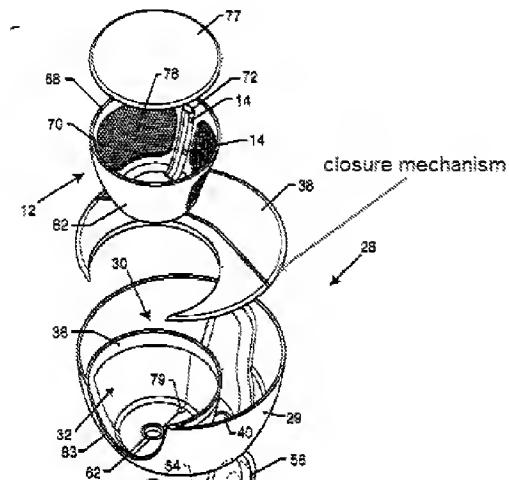
Rejections Under 35 U.S.C. § 102(e)

Claims 1-3 and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Burrows et al. US 6,968,775 B2 (“Burrows”). It is respectfully submitted that claims 1-3 and 17 are not anticipated by Burrows.

With regard to claim 1, Burrows fails to disclose or suggest an insert for use in a beverage preparation machine of a type comprising a brew head, the brew head comprising a closure mechanism, and “the insert comprising a receptacle and sealing means,” wherein “on insertion of the insert into the brew head of the beverage preparation machine and movement of the closure mechanism into the closed position the sealing means is contactable with, and sealable against, the brew head to thereby close the opening of the receptacle to define a brewing volume” as recited in claim 1.

The Response to Arguments portion of the Office Action states, with reference to Burrows, that “the structures shown ... can be controlled to perform the function.” (Office Action, page 10). Applicants respectfully submit that Burrows does not describe such structures and controllability to perform the function.

The closing of the lid 38 over the reservoir 30 in Burrows does not cause the cap 77 to be sealable against the brew head 28 to close the top of the brew basket 12. The hinged lid 38, which is described in Burrows at col. 4, lines 32-37, is spaced from the cap 77 of the brew basket 12 by an intermediate structure (see annotated Figure 3, below). That intermediate structure is neither part of the cap 77 nor the lid 38. Instead, the cap 77 and the lid 38 function independent of each other. They do not contact each other regardless of whether the lid 38 is in the open or closed position during normal operation.



In the Response to Arguments section of the Office Action at page 11, a portion of the exploded perspective view of Figure 6 of Burrows is reproduced (see left). In the Office Action, the Examiner has annotated the Figure with a guideline to the Burrows' coffee maker that is also indicated by the reference numeral 38 alleging that the entire structure is the closure mechanism.

However, the entire portion indicated by the term "closure mechanism" in the exploded prospective view provided in the Office Action is not the rear hinged lid 38 as described in Burrows. Instead, the alleged "closure mechanism" is composed of the rear hinged lid 38 and a separate stationary front reservoir cover portion as indicated by the term "intermediate structure" in annotate Figure 3 of Burrows (see right). This stationary front reservoir cover portion substantially surrounds the brewer basket cavity 32 while spacing and separating the rear hinged lid 38 from the brewer basket cavity 32. Similarly, in Figures 1, 2, and 4, a line can be clearly seen that separates the rear hinged lid 38 from the front reservoir cover portion and would indicate that the rear hinged lid 38 is spaced in the closed position from the brewer basket cavity 32 which holds the brew basket 12 and lid 77.

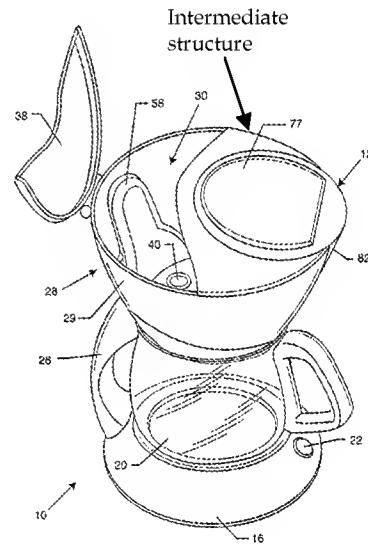


FIG. 3

In the present claim, movement of the closure mechanism into the closed position brings the sealing means into contact with the brew head and causes the brew head to thereby close the opening of the insert receptacle to define the brew volume. This claim element cannot be ignored. "A functional limitation must be evaluated and considered, just like any other

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limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” MPEP 2173.05(g).

As lid 38 never touches cap 77 of the receptacle 12 because they are spaced from each other by the “intermediate structure”, Burrows fails to disclose that the act of closing the rear hinged lid 38 causes the cap 77 to be contactable with and sealable against the lid 38 or brewer head 28. Therefore, Burrows does not have the structure to perform this claim element.

Further, there is no disclosure in Burrows that the closure of the rear hinged lid 38 to cover the opening of reservoir 30 in any way affects the operation of the brew basket 12 or its lid 77 or how closing of the rear hinged lid 38 would cause the brew head to thereby close the opening of the receptacle to define a brew volume. Therefore, Burrows also does not have the controllability to perform this claim element.

For at least the above discussed reason, Applicants assert that Burrows fails to disclose or suggest claim 1 and thereby request reconsideration and allowance of claim 1. Similarly, Applicants assert that claims 2-40, dependent from claim 1, are allowable as well.

Rejections Under 35 U.S.C. § 103

Claims 4-13, 18-20, and 22-25 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows. Claims 14-16 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows, and in view of Cai US 7,032,503. Claims 21 and 26-40 stand rejected under 35 U.S.C. § 103(a) as obvious over Burrows, and in view of Halliday US 2004/0197444 A1. In view of the above discussion of Burrows as applied to claim 1, it is respectfully asserted that claims 4-16, and 18-40, dependent therefore, are allowable as well.

With specific respect to claims 5-7, Burrows teaches away from the claimed flexible container. Instead, Burrows discloses a rigid brew basket that relies upon a specific structure including a plenum chamber 70 for distributing hot water to a plurality of hollow ribs 72 with jet ports 14 for purposes of exposing “the entire volume of the coffee grounds to the heated water thoroughly and substantially uniformly.... (Col. 6, ll. 21-23.) This is in contrast to the

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problem described as being with the prior art, e.g., "inadequate and/or inconsistent intermixing of hot water with the coffee grounds contained in the brew basket.... (Col. 1, ll. 32-38.) Moreover, the Office action fails to identify any motivation for the proposed modification to Burrows.

With specific regard to claim 18, Burrows fails to disclose or suggest that pressure applied to the insert "by the closure mechanism of the beverage preparation machine on closing of said closure mechanism squeezes the insert with sufficient force for the sealing means to seal against the brew head" as recited in claim 18.

The Office Action, p. 5, states:

However it would have been obvious to a person of ordinary skill in the art at the time of the invention to extend the lid 38 to cover the whole top section of brew head 28 to prevent dust from getting in the cavity 32 and to improve hygiene; and to leave a window portion for viewing inside the brewing chamber. Thus when pressure is applied to the extended lid to close the lid portion, cap 12 of the insert will be squeezed to seal against the receptacle of 12, and the lower surface of the insert 12 will seal against the inlet of the brew head for hot water communication.

However, as can be seen from the Figures of Burrows, the cap 77 stands above the top of the brewer head 28, such that if the lid 38 were extended to cover the whole top of the brewer head 28 as the Office Action proposes, the lid 38 would angle up from the edge of the reservoir due to contact with the elevated cap 77 and not fully close the reservoir. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP 2143.01. Modifying the lid 38 as proposed would cause a portion of the reservoir to remain open and render the lid unsatisfactory for its intended purpose.

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Conclusion

For the reasons discussed above, reconsideration and allowance of claims 1-40 are respectfully requested. The Examiner is invited to contact the undersigned attorney to expedite prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

Dated: September 28, 2010

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